

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-9, 16 and 23 are requested to be canceled.

Claims 10-15 and 26 are currently being amended. Support for these amendments can be found, for example, on pages 22-23 and 35-44 of the specification, along with the associated figures.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 10-15 and 26 are now pending in this application.

In the Office Action, the title was objected to because the specification provided insufficient written support for a “digital copying machine.” By this Amendment, the title has been amended to be consistent with and supported by the written description. Accordingly, Applicants request that the objection to the title be withdrawn.

Claims 1-16, 23, and 26 were rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement. By this Amendment, Applicants have amended the claims to remove the recitation of a “digital copying machine.” Accordingly, Applicants submit that the claims comply with the written description requirement of 35 U.S.C. § 112, ¶ 1 and request that this rejection be withdrawn.

Claims 1-16, 23, and 26 were also rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite. By this Amendment, Applicants have amended the claims to remove the recitation of a “digital copying machine.” Accordingly, Applicants submit that the claims are definite and in compliance with 35 U.S.C. § 112, ¶ 2, and thus request that this rejection be withdrawn.

Claims 1, 2, 4-7, 9, and 23 were rejected under 35 U.S.C. § 102(b) as being anticipated by the recommend-it.com website (May 30, 1998), and claims 3 and 8 were

rejected under 35 U.S.C. § 103(a) as being unpatentable over recommend-it.com in view of Official Notice. In view of the cancellation of these claims, these rejections are now moot.

Claims 10-12, 15, 16, and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by the America Online Tour Guide Version 3 published in 1996 ("AOL Guide"). Claim 10, as amended, recites that an advertisement system which provides an advertisement of merchandise to a number of users comprises a first display portion which displays the advertisement of merchandise, a memory which stores, as a bookmark, information associating information related to the piece of merchandise displayed by said first display portion with information indicative of a user, a registration button which instructs to register the information related to the piece of merchandise as the bookmark in a memory when the advertisement of the piece of merchandise is being displayed on said display device, and a second display portion which displays a selection window for designating a user, when the registration button is pressed.

Claim 10 further recites that the advertisement system comprises a registration processing portion which, when a specific user is designated in a state where the selection window is displayed in said second display portion, causes said memory to store bookmark information associating information indicative of the designated user with information related to the piece of merchandise displayed by said first display portion when said registration button is pressed, a search portion which searches all bookmark information corresponding to the information indicative of the designated user, when the information indicative of the user is received from an external device, and a transmitter that transmits the information related to the piece of merchandise based on the bookmark information searched by said search portion to the external device as data displayable on the external device, the data displayable on the external device containing link information linked with a site on the Internet where the piece of merchandise is on sale.

The AOL Guide discloses a system for identifying, selecting, and storing "Favorite Places" that a user would like to visit while exploring the Web (pp. 127-129). In particular, a user can click on a heart icon of a web page and drag it to a "Favorite Places" icon on a toolbar (p. 127). To open the "Favorite Places" window, a user clicks an icon on the toolbar, and to go to a "Favorite Place" listed in the window, the user just double-clicks on the desired place (p. 129).

In contrast to claim 10, the AOL Guide fails to disclose or suggest several recitations of claim 10. For example, the AOL Guide fails to disclose or suggest a second display portion which displays a selection window for designating a user, when the registration button is pressed. None of the figures in the AOL Guide shows a display portion for designating a user, nor is there any description of such a display portion

The AOL Guide also fails to disclose or suggest a registration processing portion which, when a specific user is designated in a state where the selection window is displayed in said second display portion, causes said memory to store bookmark information associating information indicative of the designated user with information related to the piece of merchandise displayed by said first display portion when said registration button is pressed. Rather, as discussed above, a user simply drags an icon for a web page to an icon in the AOL Guide. There is nothing in the AOL Guide that discloses or suggests associating a designated user with the web place requested to become a "Favorite Place."

Likewise, the AOL Guide fails to disclose or suggest a search portion which searches all bookmark information corresponding to the information indicative of the designated user, when the information indicative of the user is received from an external device. In fact, there is no mention of a search function anywhere in the AOL Guide. Moreover, since the AOL Guide does not disclose or suggest associating a designated user with a "Favorite Place," the AOL Guide necessarily fails to disclose or suggest searching for bookmark information corresponding to a designated user.

Accordingly, for all of these reasons, claim 10 is patentably distinguishable from the AOL Guide. Claims 11-12 and 15 are also patentably distinguishable from the AOL Guide by virtue of their dependence from claim 10, as well as their additional recitations. Claim 26 is patentably distinguishable from the AOL Guide for reasons analogous to claim 10.

Lastly, claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the AOL Guide in view of Official Notice. Regardless of the propriety of the Official Notice or the combinability of the Official Notice with the AOL Guide, claims 13 and 14 are patentably distinguishable from the combination of the AOL Guide in view of Official Notice by virtue of their dependence from claim 10, as well as their additional recitations.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date: August 9, 2006

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 945-6162
Facsimile: (202) 672-5399

By 

Pavan K. Agarwal
Registration No. 40,888

Marc K. Weinstein
Registration No. 43,250

Attorneys for Applicants